



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Hyun-Jeong KIM

Examiner: LY, Nghi H.

Serial No.: 09/734,852

Group Art Unit: 2686

Filed: December 11, 2000

Docket: 678-578

For: **METHOD OF NOTIFYING A CALLER OF MESSAGE CONFIRMATION IN A WIRELESS COMMUNICATION SYSTEM**

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313

TRANSMITTAL OF APPELLANT'S BRIEF ON APPEAL

Sir:

Enclosed please find APPELLANT'S BRIEF.

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Respectfully submitted,

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Dated: March 27, 2006

Michael J. Musella



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES**

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APPEAL BRIEF

REAL PARTY IN INTEREST

The real party in interest is Samsung Electronics Co, Ltd, the assignee of the subject application, having an office at 416, Maetan-dong, Yeongtong-gu, Suwon-si, Gyeonggi-do, Republic of Korea.

RELATED APPEALS AND INTERFERENCES

To the best of Appellant's knowledge and belief, there are no currently pending related appeals, interferences or judicial proceedings.

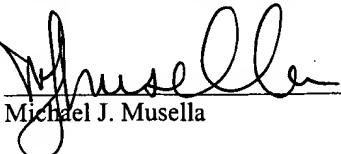
STATUS OF CLAIMS

Original Claims 1-15 were filed on December 11, 2000. Claim 1 was amended in an

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Dated: March 27, 2006



Michael J. Musella

Amendment filed November 25, 2003. Claims 16 and 17 were added in an Amendment filed May 18, 2004. Claims 1-15 were cancelled, Claim 16 was amended, and Claims 18-27 were added in an Amendment filed January 5, 2005. Thus, Claims 16-27 are pending in the Appeal. Claims 16 and 21 are in independent form. For the purposes of this appeal, Claims 16-20 stand or fall together, and Claims 21-27 stand or fall together.

STATUS OF AMENDMENTS

Thus, the Appendix to this Appeal Brief includes independent Claims 16 and 21, along with dependent Claims 17-20 and 22-27.

SUMMARY OF CLAIMED SUBJECT MATTER

The invention as recited in Claim 16 relates to a method of communicating a confirmation message.

The method informs a called mobile station of receipt of a message from a calling mobile station.

The method determines, if the received message is a text message, if a called party of the called mobile station has confirmed the received message, which is stored in the called mobile station.

The method transmits, from the called mobile station, a confirmation message to be delivered to the calling mobile station, wherein the confirmation message is generated by the called mobile station when the called mobile station has confirmed the received message.

The method includes that the confirmation message includes a telephone number of the calling mobile station.

The invention as recited in Claim 21 also relates to a method of communicating a confirmation message.

The method determines, when a voice call is not normally established between a called mobile station and a calling mobile station, if a called party of the called mobile station has confirmed a message created and transmitted by the calling mobile station.

The method generates, by the called mobile station, a confirmation message indicating the

confirmation by the called party.

The method transmits, from the called mobile station, the confirmation message to the calling mobile station.

GROUNDS FOR REJECTION TO BE REVIEWED ON APPEAL

Whether Claim 16 under 35 U.S.C. §103(a) is unpatentable over U.S. Patent 6,216,106 to John (“John”) in view of U.S. Patent 5,280,521 to Itoh (“Itoh”) and further in view of U.S. Patent 6,477,243 to Choksi et al. (“Choksi”).

Whether Claim 21 under 35 U.S.C. §103(a) is unpatentable over U.S. Patent 6,216,106 to John (“John”) in view of U.S. Patent 5,280,521 to Itoh (“Itoh”).

ARGUMENT

1. Independent Claim 16 is patentable over John in view of Itoh and Choksi

Independent Claim 16 was said to be unpatentable over John, in view of Itoh, and further in view of Choksi.

John discloses a method and arrangement in a communications network. The invention disclosed by John relates to a service in a communication network comprising a voice messaging system containing a mailbox assigned to a voice mail subscriber. According to the invention, the communication network transfers a voice message from the calling party to the voice messaging system where the message is stored in the mailbox. At some later point in time, the communication network transfers a request for the status of the voice message from the calling party to the voice messaging system. The voice messaging system returns information reflecting the status of the voice message to the calling party. In response to activities performed by the voice mail subscriber on the voice message, the message status may be changed in between storage of the voice message and receipt of the status request in the voice messaging system. John teaches that the voice messaging system VMS1 in FIG. 1 plays a second voice message (see Column 4, lines 41-47). Further, the VMS1 is not included the mobile station, and therefore, fails to teach generating and transmitting, by the called mobile station, a confirmation message indicating the confirmation by the called party to the calling mobile station. John teaches generating information indicating a

status of a voice message in a voice message system, upon receiving a caller's request, not at the same time a message is confirmed by the called party.

Itoh discloses a portable telephone system. According to Itoh, a portable telephone system is disclosed in which a plurality of i -th class exchanges, which accommodate key service units of a plurality of portable telephone sets present in each service area, and at least one $(i+1)$ -th class exchange which accommodates the plurality of i -th class exchanges through junction lines, are stratified to form an exchange system so that $i=1, 2, 3, \dots$, and so that the $(i+1)$ -th class exchange covers all service areas. The exchange system has a function whereby information which specifies the home area of each portable telephone set and the portable telephone set in distinction from each other is registered in the i -th class exchange and the $(i+1)$ -th class exchange, which administer the home area.

Choksi discloses a method and apparatus for automated facsimile message confirmation. According to Choksi, integration of telecommunication message services and other communication services is achieved by notifying a user of a communication system of successful receipt of a message (e.g., a facsimile message) by sending a confirmation message to the user, e.g., using e-mail, facsimile, voice and/or data communications. The user may be identified by a unique identifier, e.g., a telephone number. The confirmation message may comprise a facsimile message, an attachment which includes the received message or a computer network address of a location where information regarding the received message and/or the message itself may be accessed. For the latter case, the computer network address is preferably a universal resource locator associated with a web page at which the information and/or received message may be accessed. The information may allow the user to view the message (e.g., as marked up by the intended recipient thereof), and/or it may indicate whether the intended recipient has read, reviewed, down-loaded to a hard copy or other device or otherwise accessed the message.

Claim 16 recites, among other elements, a method of communicating a confirmation message. If the received message is a text message, the method determines if a called party of the called mobile station has confirmed the received message. The method transmits, from the called mobile station, a confirmation message to be delivered to the calling mobile station, wherein the confirmation message is generated by the called mobile station when the called mobile station has confirmed the received message.

Claim 16 recites the step of generating and transmitting, **by the called mobile station**, a confirmation message indicating the **confirmation by the called party**. The confirmation message is transmitted **to the calling mobile station**. However, it is respectfully submitted that John in view of Itoh and Choksi does not teach these features of the present invention.

More specifically, Itoh, discloses that if a called terminal receives a message from a calling terminal, the called terminal transmits an answering signal without regard to if a called party confirms a message or not to enable the calling terminal to check if the called terminal correctly received the message. That is, the calling terminal cannot check if the **called party** has confirmed the message, but can only check that the message is received in the called terminal. As Choksi deals with a receipt notification containing a telephone number, and not if a calling terminal can check if the **called party** has confirmed the message, Choksi does not cure this defect.

Further, although John teaches notifying a calling party of a message confirmation of a called party, it is only by a confirmation message generated in a server, after a request is made by the calling party.

Therefore, assuming only for argument sake that these references are combinable with each other, when a called terminal confirms a message, a confirmation message is generated and stored in a server, not directly transmitted to a calling terminal. Accordingly, based on the combination of these references, the calling terminal must then transmit a request for message confirmation in order to receive the message confirmation of the called terminal from the server.

However, as recited in independent Claim 16, when a called party confirms a message, a confirmation message is directly transmitted to the calling party. Therefore, it is not necessary to store the confirmation message in a separate server, as is necessary in the combination of John in view of Itoh. As Choksi deals with a receipt notification containing a telephone number, and not when a called party confirms a message, a confirmation message is directly transmitted to the calling party, Choksi does not cure the defects created by John and Itoh.

The Examiner has failed to show that all of the recitations of Claim 16 are taught in or suggested by the prior art. The Examiner has failed to make out a *prima facia* case for an obviousness rejection.

Independent Claim 16 is not rendered unpatentable by John in view of Itoh and Choksi, thus Claims 16-20 are allowable.

2. Independent Claim 21 is patentable over John in view of Itoh

Independent Claim 21 was said to be unpatentable over John in view of Itoh.

John discloses a method and arrangement in a communications network. The invention disclosed by John relates to a service in a communication network comprising a voice messaging system containing a mailbox assigned to a voice mail subscriber. According to the invention, the communication network transfers a voice message from the calling party to the voice messaging system where the message is stored in the mailbox. At some later point in time, the communication network transfers a request for the status of the voice message from the calling party to the voice messaging system. The voice messaging system returns information reflecting the status of the voice message to the calling party. In response to activities performed by the voice mail subscriber on the voice message, the message status may be changed in between storage of the voice message and receipt of the status request in the voice messaging system. John teaches that the voice messaging system VMS1 in FIG. 1 plays a second voice message (see Column 4, lines 41-47). Further, the VMS1 is not included the mobile station, and therefore, fails to teach generating and transmitting, by the called mobile station, a confirmation message indicating the confirmation by the called party to the calling mobile station. John teaches generating information indicating a status of a voice message in a voice message system, upon receiving a caller's request, not at the same time a message is confirmed by the called party.

Itoh discloses a portable telephone system. According to Itoh, a portable telephone system is disclosed in which a plurality of i-th class exchanges, which accommodate key service units of a plurality of portable telephone sets present in each service area, and at least one (i+1)th class exchange which accommodates the plurality of i-th class exchanges through junction lines, are stratified to form an exchange system so that $i=1, 2, 3, \dots$, and so that the (i+1)th class exchange covers all service areas. The exchange system has a function whereby information which specifies the home area of each portable telephone set and the portable telephone set in distinction from each other is registered in the i-th class exchange and the (i+1)th class exchange, which administer the home area.

Claim 21 recites, among other elements, a method of communicating a confirmation message. When a voice call is not normally established between a called mobile station and a

calling mobile station, the method determines if a called party of the called mobile station has confirmed a message created and transmitted by the calling mobile station. The method generates, by the called mobile station, a confirmation message indicating the confirmation by the called party. The method transmits, from the called mobile station, the confirmation message to the calling mobile station.

Claim 21 recites the step of generating and transmitting, **by the called mobile station**, a confirmation message indicating the **confirmation by the called party**. The confirmation message is transmitted **to the calling mobile station**. However, it is respectfully submitted that John in view of Itoh does not teach these features of the present invention.

More specifically, Itoh, discloses that if a called terminal receives a message from a calling terminal, the called terminal transmits an answering signal without regard to if a called party confirms a message or not to enable the calling terminal to check if the called terminal correctly received the message. That is, the calling terminal cannot check if the **called party** has confirmed the message, but can only check that the message is received in the called terminal.

Further, although John teaches notifying a calling party of a message confirmation of a called party, it is only by a confirmation message generated in a server, after a request is made by the calling party.

Therefore, assuming only for argument sake that these references are combinable with each other, when a called terminal confirms a message, a confirmation message is generated and stored in a server, not directly transmitted to a calling terminal. Accordingly, based on the combination of these references, the calling terminal must then transmit a request for message confirmation in order to receive the message confirmation of the called terminal from the server.

However, as recited in independent Claim 21, when a called party confirms a message, a confirmation message is directly transmitted to the calling party. Therefore, it is not necessary to store the confirmation message in a separate server, as is necessary in the combination of John in view of Itoh.

The Examiner has failed to show that all of the recitations of Claim 21 are taught in or suggested by the prior art. The Examiner has failed to make out a *prima facia* case for an obviousness rejection.

Independent Claim 21 is not rendered unpatentable by John in view of Itoh, thus Claims

21-27 are allowable.

CONCLUSION

Based on at least the foregoing, as the Examiner has failed to make out a *prima facia* case for an obviousness rejection, the rejection of Claims 16 and 21 must be reversed.

It is well settled that in order for a rejection under 35 U.S.C. §103(a) to be appropriate, the claimed invention must be shown to be obvious in view of the prior art as a whole. A claim may be found to be obvious if it is first shown that all of the recitations of a claim are taught in the prior art or are suggested by the prior art. In re Royka, 490 F.2d 981, 985, 180 U.S.P.Q. 580, 583 (C.C.P.A. 1974), cited in M.P.E.P. §2143.03.

The Examiner has failed to show that all of the recitations of Claim 16 are taught in or suggested by the prior art. The Examiner has failed to make out a *prima facia* case for an obviousness rejection.

The Examiner has failed to show that all of the recitations of Claim 21 are taught in or suggested by the prior art. The Examiner has failed to make out a *prima facia* case for an obviousness rejection.

Independent Claim 16 is not rendered unpatentable by John in view of Itoh and Choksi, thus Claims 16-20 are allowable.

Independent Claim 21 is not rendered unpatentable by John in view of Itoh, thus Claims 21-27 are allowable.

Dated: March 27, 2006

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CLAIMS APPENDIX

1-15. (Cancelled)

16. (Previously Presented) A method of communicating a confirmation message, comprising the steps of:

informing a called mobile station of receipt of a message from a calling mobile station;

determining, if the received message is a text message, if a called party of the called mobile station has confirmed the received message, which is stored in the called mobile station; and

transmitting, from the called mobile station, a confirmation message to be delivered to the calling mobile station, wherein the confirmation message is generated by the called mobile station when the called mobile station has confirmed the received message and the confirmation message includes a telephone number of the calling mobile station.

17. (Previously Presented) The method of Claim 16, further comprising the step of determining, if the received message is a voice message, whether the called mobile station is connected to a voice mail center in order to confirm the received voice message.

18. (Previously Presented) The method of Claim 16, wherein the confirmation message is a data burst message.

19. (Previously Presented) The method of Claim 16, wherein the confirmation message is a short message.

20. (Previously Presented) The method of Claim 16, further comprising the steps of:

sounding an alarm; and

displaying, in the calling mobile station, information indicating receipt of the confirmation message, upon receipt of the confirmation message.

21. (Previously Presented) A method of communicating a confirmation message,

comprising the steps of:

 determining, when a voice call is not normally established between a called mobile station and a calling mobile station, if a called party of the called mobile station has confirmed a message created and transmitted by the calling mobile station;

 generating, by the called mobile station, a confirmation message indicating the confirmation by the called party; and

 transmitting, from the called mobile station, the confirmation message to the calling mobile station.

22. (Previously Presented) The method of Claim 21, wherein the message transmitted by the calling mobile station is a voice message.

23. (Previously Presented) The method of Claim 21, wherein the message transmitted by the calling mobile station is a text message.

24. (Previously Presented) The method of Claim 21, wherein the confirmation message is a data burst message.

25. (Previously Presented) The method of Claim 21, wherein the confirmation message is a short message.

26. (Previously Presented) The method of Claim 21, further comprising the steps of:
 sounding an alarm, and displaying, in the calling mobile station, information indicating receipt of the confirmation message, upon receipt of the confirmation message.

27. (Previously Presented) The method of Claim 21, wherein the confirmation message includes a telephone number of the calling mobile station.

EVIDENCE APPENDIX

There is no evidence submitted pursuant to 37 C.F.R. 1.130, 1.131, 1.132 or entered by the Examiner and relied upon by Appellant.

RELATED PROCEEDINGS APPENDIX

There are no known decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of 37 C.F.R. 41.37.